

**REMARKS****Introductory Comments**

Claims 14-21, 23-30, 32-38 and new claims 41-52 are pending in this application, of which claims 20, 24, 28-30, 34 and 37 have been withdrawn from consideration. Claims 1-13, 22, 31 and 39-40 have been cancelled without prejudice or disclaimer of the subject matter recited therein.

Applicants do not acquiesce in the Examiner's rejections, but instead have elected to make the above-mentioned amendments in an effort to expedite prosecution of this application leading to issuance of a patent. Reconsideration of the application as amended above and in view of the following remarks is respectfully requested.

**Claim Objections / Allowable Subject Matter**

Applicants acknowledge with appreciation the Examiner's indication that claims 11-12 and 39-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 11-12 have been cancelled and claims 45-52 added to contain the limitations of previous claims 39-40. In view of the Examiner's comments, Applicants submit that claims 45-52 are *prima facie* allowable.

Claim 21 has been objected to for containing the term "overlay". Applicants have amended this claim accordingly to overcome this objection.

Claims 25-27, 33, 35, 36 and 38-40 were objected to by the Examiner as containing the same limitations as recited in claims 1, 3-7 and 10-12, respectively. Appropriate correction has been rendered whereby this objection has been overcome.

**Prior Art Rejections**

The Examiner rejected claims 1-4 and 25-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,377,370 to Foster et al. ("Foster"). The Examiner rejected claims 5-10, 13, 21, 22, 33, 35, 36 and 38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,357,065 to Adams and claims 14-19 as being anticipated by U.S. Patent No. 5,628,078 to Pennington et al ("Pennington"). The Examiner also rejected claims 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Pennington, as well as claim 32 as being unpatentable over Foster.

**§ 102(b) – Foster**

As stated above, the Examiner rejected claims 1-4 and 25-27 as being anticipated by Foster. While claims 1-4 have been cancelled, the limitation of claim 2 has been

incorporated into newly presented claim 41, which depends from independent claim 25. As such, Applicants' response to this rejection is in view of pending claims 25-27 and 41.

Applicants respectfully submit that Foster simply does not support the Examiner's rejection under § 102(b) in light of the amendments and arguments made in this response. The case law is clear on this point, "anticipation requires that a single prior art reference disclose every limitation of the patent claim." General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (citing PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)) ("to anticipate a claim, a reference must disclose every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter."). More particularly, the Federal Circuit has held that the test for anticipation is "[t]hat which would literally infringe if later in time anticipates if earlier than the date of invention." Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 3 USPQ2d 1776 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

#### Claim 25

The Examiner has failed to establish a *prima facie* case of anticipation by failing to particularly point out the elements in Foster which allegedly correspond to each of the limitations of claim 25. At a minimum, Foster fails to teach or suggest a combination of an apparatus configured to be located on the frame of a patient support and comprising "a mattress....having an upper surface....a lower surface, and first and second spaced apart side portions which define a width dimension of the mattress which is greater than the width dimension of the top surface of the frame.....a continuous support surface extending along the width dimension of the mattress; and a support coupled to the patient support to support portions of the lower surface of the mattress adjacent the first and second sides of the mattress which extend beyond the first and second sides of the frame," as required by claim 25.

In making this rejection, the Examiner merely cites to various sections of Foster, however, fails to particularly point out how the elements of Foster allegedly correspond to the present invention. The Examiner particularly notes Figures 1-4; column 1, lines 18-49; column 2, lines 10-28; column 3, lines 15-68; and column 4, lines 1-24. After carefully reviewing Foster, and particularly the abovementioned sections, Applicants find no teaching or suggestion by Foster of an apparatus as presently claimed. According to Foster, "the wings 12 contribute to support of the mattress 26" (column 3, lines 25-27) and when "the wing 12 translates inwardly toward the bed frame 16", the mattress 26 positioned thereon deforms as shown in Figure 2 (Column 3, lines 35-37). Foster does not disclose, teach, or

suggest an apparatus having a mattress section combined with a patient support, wherein the width dimension of the mattress is greater than the width dimension of the top surface of the apparatus frame as required by claim 25. As Foster does not disclose each element of the claimed invention nor anticipate the claimed invention, a rejection under 35 U.S.C. § 102 cannot be supported.

Therefore, Applicants believe that claim 25 is in condition for allowance with respect to Foster. Removal of the rejection and allowance of claim 25 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

Claims 26-27 and 41

Claims 26-27 and 41 depend from claim 25. In that claim 25 is believed to be allowable, claims 26-27 and 41 are also believed to be allowable. Removal of the rejection and allowance of claims 26-27 and 41 is respectfully requested.

§ 102(b) – Adams

As stated above, the Examiner rejected claims 5-10, 13, 21, 22, 33, 35, 36 and 38 as being anticipated by Adams. While claims 5-10 and 13 have been cancelled, the limitations of claims 8, 9 and 13 have been incorporated into newly presented claims 42, 43 and 44, respectively, which depend from independent claim 33. Moreover, the limitation of claim 22 has been incorporated into independent claim 21. As such, Applicants response to this rejection is in view of pending claims 21, 33, 35-36, 38 and 42-44.

Adams relates to "a variable width bariatric bed including a frame having a modular configuration with front end, rear end and middle sections that are detachable from one another to facilitate storage, transport and relocation through narrow entrances." (Adams, Abstract). More particularly, Adams discloses a pair of pull out extensions 76-79 attached to a bed frame 1 which are capable of being outwardly pulled in opposite directions from a head mattress support deck section 50 through the assistance of opposing pairs of rails 80 along the bottom of each pull out extension. (Adams, column 5, lines 44-67 and column 6, lines 1-12).

Claim 21

The Examiner has failed to establish a *prima facie* case of anticipation by failing to particularly point out the elements in Adams which allegedly correspond to each of the limitations of claim 21. More particularly, Adams fails to teach or suggest a patient support having an overlay coupled to a retainer and configured to maintain the overlay in a desired position relative to the patient support, such as required by claim 21. Rather, Adams merely teaches of a narrow bed frame capable of having its width dimension increased by pulling on

extensions, which are connected to the bed frame. Applicants find no teaching or suggestion by Adams wherein a patient support comprises a combination of a patient support surface coupled to a bed frame together with an extender further coupled thereto to thereby allow the patient support to be increased in width, and particularly wherein the patient support comprises an overlay coupled with a retainer to maintain the overlay in a desired position, as well as first and second accessory rails of which are coupled to the frame such as required by claim 21.

"Anticipation requires that a single prior art reference disclose every limitation of the patent claim. General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (citing PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)) ("to anticipate a claim, a reference must disclose every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter."). As the patient support of claim 21 requires a patient support surface to be coupled to a bed frame together with an extender further coupled thereto to allow the patient support surface to be increased in width, particularly wherein the patient support comprises an overlay coupled with a retainer to maintain the overlay in the desired position , as well as first and second accessory rails of which are coupled to the frame, Adams does not disclose each element of the claimed invention nor anticipate the claimed invention under 35 U.S.C. § 102.

It is thus submitted that the rejection of claim 21 in view of Adams has been overcome. Reconsideration is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

#### Claim 33

The Examiner has also failed to establish a *prima facie* case of anticipation for claim 33 in view of Adams by failing to particularly point out the elements in Adams which allegedly correspond to each of the limitations of claim 33. More specifically, Adams fails to teach or suggest an apparatus configured to be located on a frame of a patient support comprising *inter alia*, a retainer having first and second members configured to engage first and second accessory rails to maintain a width extender in a desired position on the frame, such as required by claim 33. Rather, as explained in detail above, Adams merely teaches of a narrow bed frame capable of having its width dimension increased by pulling on extensions, which are connected to the bed frame. As the apparatus of claim 33 requires a patient support surface to be coupled to a bed frame together with a width extender and a retainer having first and second members configurcd to engage first and second accessory

rails to maintain the width extender in a desired position, Adams does not disclose each element of the claimed invention nor anticipate the claimed invention under 35 U.S.C. § 102.

It is thus submitted that the rejection of claim 33 in view of Adams has been overcome. Reconsideration is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

Claims 35, 36, 38

Claims 35, 36 and 38 depend from claim 33. In that claim 33 is believed to be allowable, claims 35, 36 and 38 are also believed to be allowable. Removal of the rejection and allowance of claims 35, 36 and 38 is respectfully requested.

§ 102(b) – Pennington

The Examiner rejected claims 14-19 as being anticipated by Pennington. Pennington teaches a side extender assembly for providing additional width to a surgical table, wherein the assembly includes an extender frame having at least one support leg integral therewith. (Pennington, Abstract). The support leg includes a recess for receiving a side rail of the surgical table and a tang defining an upper portion of the recess which extends over and behind the side rail in a mounted position. (Pennington, Abstract). The side extender assembly is adapted to be used in conjunction with side rails, such as a back section side rail 240 and a seat section side rail 242 (Pennington, column 13, lines 44-47 and Figure 1) and a plurality of extender assemblies 238 may be used along the length of the table 10 (Fig. 31).

Claim 14

The Examiner failed to establish a *prima facie* case of anticipation for claim 14 in view of Pennington by failing to particularly point out the elements in Pennington which allegedly correspond to each of the limitations of claim 14. More particularly, Pennington fails to teach or suggest a method of supporting a patient comprising, *inter alia*, a patient support apparatus with a removable and storable patient support surface coupled thereto, such as required by claim 14. Rather, Pennington teaches of a side extender assembly including an extender frame which appears to be fixably mounted to the surgical table assembly. As such, Pennington fails to teach and/or appreciate the removable and storable aspects of the presently claimed invention. As the method of claim 14 requires the patient support surface to be "removable and storable", Pennington does not disclose each element of the claimed invention nor anticipate the claimed invention under 35 U.S.C. § 102.

It is thus submitted that the rejection of claim 14 in view of Pennington has been overcome. Reconsideration is respectfully requested. If the Examiner should disagree with

the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these limitations are expressly disclosed.

Claims 15-19

Claims 15-19 depend from claim 14. In that claim 14 is believed to be allowable, claims 15-19 are also believed to be allowable. Removal of the rejection and allowance of claims 15-19 is respectfully requested.

§ 103(a) - Pennington

The Examiner has rejected claims 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Pennington.

As discussed in detail above, Pennington teaches a side extender assembly for providing additional width to a surgical table, wherein the assembly includes an extender frame having at least one support leg integral therewith. (Pennington, Abstract). The support leg includes a recess for receiving a side rail of the surgical table and a tang defining an upper portion of the recess which extends over and behind the side rail in a mounted position. (Pennington, Abstract). The side extender assembly is adapted to be used in conjunction with side rails, such as a back section side rail 240 and a seat section side rail 242 (Pennington, column 13, lines 44-47 and Figure 1) and a plurality of extender assemblies 238 may be used along the length of the table 10 (Fig. 31).

Claim 21

The Examiner has failed to establish a *prima facie* case of obviousness for claim 21 in view of Pennington by failing to demonstrate the requisite motivation needed to modify the prior art to reach the claimed invention. More particularly, when claims are rejected under 35 U.S.C. § 103(a), it is the Examiner's burden to establish a *prima facie* case of obviousness, namely, that there is a suggestion or motivation in the prior art to modify the reference teachings in the manner claimed, that the cited reference teaches or suggests all of the claimed limitations, and that there is a reasonable expectation of success. (MPEP §§ 2142-2143).

The Examiner has not established a *prima facie* case of obviousness because Pennington fails to teach a patient support having a patient support surface coupled to a frame, wherein the patient support further comprises an overlay coupled to a retainer configured to maintain the overlay in a desired position relative to the patient support system, such as required by claim 21. More particularly, the patient support of the present invention relates to a patient support surface which can be easily installed and removed from an operating table, for instance, as well as easily stored. (See paragraph 0008 of the published

Application). Pennington, on the other hand, is directed to a side extender assembly including an extender frame which is fixably mounted to the surgical table assembly. As such, Pennington fails to teach and/or appreciate the removable and storable aspects of the presently claimed invention. Thus, one skilled in the relevant art would have no desire or motivation from the teachings of Pennington to reach the present invention.

In view of the failure of Pennington to teach or suggest the patient support as defined by claim 21, Pennington does not provide the requisite motivation to make the modifications needed to arrive at the presently claimed invention. Thus, Pennington does not support a rejection under 35 U.S.C. §103.

It is therefore submitted that the patient support defined by claim 21 is nonobvious over and patentably distinguishable from Pennington, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where in the cited references the limitation is expressly disclosed or taught.

Claim 23

Claim 23 depends from claim 21. In that claim 21 is believed to be allowable, claim 23 is also believed to be allowable. Removal of the rejection and allowance of claim 23 is respectfully requested.

§ 103(a) - Foster

The Examiner has rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Foster.

Claim 25, from which 32 depends, is discussed in detail above, as are the deficiencies of Foster with respect to claim 25. Applicants find no teaching and/or suggestion by Foster wherein an apparatus has a mattress section combined with a patient support, wherein the width dimension of the mattress is greater than the width dimension of the top surface of the apparatus frame as required by claim 25. Accordingly, one skilled in the relevant art would be unable to formulate the presently claimed apparatus from the teachings of Foster.

For at least these reasons, removal of the rejection and allowance of claim 32 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where in the cited references the limitation is expressly disclosed or taught.

Final Comments

Applicants submit that the application is now in condition for allowance and respectfully request that the same be granted. Applicants request that, if necessary, this

Amendment be considered a request for an extension of time for a time appropriate for the amendment to be timely filed. Applicants request that any required fees for filing this Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

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